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| 09/801,612 | 03/08/2001 | Gerald Francis McBrearty | AUS-2000-0941-US1 | 5322 |
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| Volet Emile International Business Machines Corporation Intellectual Law Department, Internal Zip 4054 11400 Burnet Road Austin, TX 78758 | | | DENNISON, JERRY B | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD FRANCIS MCBREARTY, SHAWN PATRICK
MULLEN, JOHNNY MENG-HAN SHIEH,
and MICHAEL WILLIAM WORTMAN

Appeal 2008-2676
Application 09/801,612
Technology Center 2400

Decided:¹ March 23, 2009

Before JAMES D. THOMAS, JOHN C. MARTIN, and HOWARD B.
BLANKENSHIP, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appeal 2008-2676
Application 09/801,612

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-45, which are all the claims in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Claim 16 is illustrative.

16. In a data processing operation having stored data in a plurality of data files, a method for protecting said data files from unauthorized users comprising:

receiving user requests for access to data files;

determining whether said requests are unauthorized intrusions into said requested data files; and

changing the identification of the requested data files responsive to a determination that a request is unauthorized.

The Examiner relies on the following references as evidence of unpatentability:

| | | |
|----------|--------------------|---------------|
| Schneck | US 5,933,498 | Aug. 03, 1999 |
| Margolus | US 2002/0038296 A1 | Mar. 28, 2002 |

Claims 1-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schneck and Margolus.

Schneck describes receiving user requests for access to data files, and determining whether the requests are authorized intrusions into the requested

data files. *See* Schneck Fig. 8, access element 114 and tamper detect mechanism 169; col. 15, l. 19 - col. 16, l. 19. If and when tampering is detected, Schneck teaches that at least the operations shown in Figure 13 are performed, which includes destroying all information in cleartext (unencrypted) files (S1300), and closing all files (step S1304).

The rejection applied against the claims acknowledges that Schneck does not teach a limitation in each of the independent claims on appeal (1, 8, 16, 23, 31, and 38). The limitation is expressed in claim 16, *supra*, as “changing the identification of the requested data files responsive to a determination that a request is unauthorized.”

Because of the deficiency in Schneck, the rejection turns to Margolus. The Examiner’s assessment of the Margolus disclosure, as set out at page 4, paragraph 4 of the Answer, appears to be correct.

Margolus describes a data repository system in which data items are identified by a “fingerprint” or hash function. Margolus ¶¶ [0048], [0057] - [0060]. The data items are written directly, but read indirectly by “named objects.” *Id.*, ¶¶ [0061] - [0062]. Access to a particular user’s data may be limited to that user (¶¶ [0054], [0074]), for example by requiring an answer to a challenge (¶ [0066]). Margolus also describes periodic back-up of data items and objects (e.g., ¶¶ [0055], [0111] - [0118], [0136] - [0145]).

Further, although the rejection lacks specificity with respect to where the teachings reside, we can assume that “Margolus teaches a data repository

with access-authorization and backup functionalities wherein existing versions of data may be replaced by a new version of the data.” (Ans. 4.)

The rejection concludes that it would have been obvious “to incorporate the data backup/replacement means of Margolus into the Schneck system for controlling access and distribution of digital property.” (Ans. 4.) The teaching taken from Margolus, to incorporate within the Schneck system, thus appears to be the “data backup/replacement means.”

We agree with Appellants that the proposed combination fails to teach changing the identification of requested data files responsive to determination that a request is unauthorized. In the context of Schneck’s deficiency with respect to the claimed subject matter, Margolus seems to represent little more than the undeniable fact that a file identifier can be changed, such as when different versions of the file are stored or overwritten in persistent memory.

In rejections under § 103, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). As the rejection does not provide persuasive evidence and reasoning why the claimed subject matter would have been *prima facie* obvious to the ordinary artisan, we cannot sustain the rejection of any claim on appeal.

Appeal 2008-2676
Application 09/801,612

CONCLUSION

The rejection of claims 1-45 under 35 U.S.C. § 103(a) as being unpatentable over Schneck and Margolus is reversed.

REVERSED

rwk

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